

REMARKS

1. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 has been cancelled. The rejection of Claim 6 is therefore moot and should be withdrawn.

2. Claims 1 - 6 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Noyes, et al.

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* basis for rejection of Claims 1 and 3 under 35 U.S.C. 102(e).

To constitute a "description" of a patented invention within the meaning of 35 USC § 102(e) the prior publication must describe the invention as claimed in full, clear and exact term so as to allow a person skilled in the art to practice the invention. Vague and general representations are not sufficient to support a defense of anticipation under the law.

U.S. Patent 6,364,452 to Noyes et al., discloses neither ascertaining a pre-selected toner density setting and selecting a print media source based upon the pre-selected toner density setting, (present application, Claim 1), nor do Noyes et al. disclose ascertaining a pre-selected print media source setting and selecting a toner density setting based upon the pre-selected print media source setting, (present application, Claim 4).

The Examiner cites Noyes et al. at col. 13, lines 30 – 36, col. 57, lines 22 – 25 and Fig. 44 as the source of the prior publication that describes the invention as claimed in full, clear and exact term so as to allow a person skilled in the art to practice the invention. At col. 13, lines 9 – 11, Noyes et al. simply acknowledge that dot allocation and arrangement during printing is limited, in part, based upon the type of paper used during printing.

During its operation, printer 10 includes different modes which may be set via commands issued to printer 10 by host processor 2 (see FIG. 1).

U.S. Patent 6,364,452, col. 13, lines 9 – 11.

At col. 13, lines 30 – 36, Noyes et al. simply acknowledge that dot allocation and arrangement during printing is limited, in part, based upon the type of paper used during printing.

At this point, it is noted that dot allocation and arrangement during printing is limited, in part, based upon the type of paper used during printing. Specifically, plain paper can absorb approximately a maximum of four small droplets in a 360 dpi pixel, whereas high resolution (hereinafter "HR-101") paper can absorb a maximum of 6 small droplets in a 360 dpi pixel.

Id. at col. 13, lines 30 – 36.

At column 31, Noyes et al. simply acknowledge that the printer driver provides detailed commands and data to the printer based upon the type of recording medium being used. More significantly, Noyes et al. teach that the print mode and conditions are provided by the user and are not default selections resulting in the pre-selection of a first print job condition or setting.

In this manner, printer driver 84 provides detailed commands and data to printer 10 based upon the type of recording medium being used, the print modes and conditions requested by the user, and other relevant print related conditions.

Id. at col. 31, lines 27 – 31.

At col. 57, Noyes et al. again acknowledge that dot allocation and arrangement during printing is limited, in part, based upon the type of paper used during printing.

Some of the printing schemes in table 385 are not applicable by definition, such as an attempt to print a Photo quality image in Draft mode, or the use of Glossy recording medium in Draft mode.

Id. at col. 57, lines 22 – 25.

Fig. 44, tables 385 - 388, are matrices that simply illustrate the complexity of the decision process taught by Noyes, et al., showing the multitude of choices for selection of print mode, resolution and media that are available. Most notably, Fig. 44, table 285 does not list auto-selection of media as a function of selection of toner density or auto-selection of toner density as a function of selection of media.

Applicant respectfully submits that insofar as Noyes et al., fails to teach the claimed invention in full, clear and exact terms and therefore fails to support the rejection of Claim1 under 35 U.S.C. 102(e), that Noyes et al., therefore also fails as a primary reference under 35 U.S.C. 103(a). In reviewing Noyes et al., is it clear that the present invention is not described in full, clear and exact terms so as to allow a person skilled in the art to practice the invention, it is also clear that Noyes et al., teach away from the present invention. Noyes et al., unlike the present invention, discuss the possibility that a user may or may not select a print mode. See U.S. Patent 6,364,452 col. 32, lines 14 – 27. According to the present invention, either a toner density setting or a print media source setting is pre-selected. Also according to Noyes et al., where the user selects a draft or standard mode, a determination is made whether the current print job is to be printed using a regular mode or whether a high resolution color mode is to be used for the print job. If a regular mode is selected, the printer driver next considers what type of recording medium is being used for the current print job. See U.S. Patent 6,364,452 col. 32, lines 28 – 48. Again, the teaching of Noyes et al., differs dramatically from that of the present invention, which based on the pre-selection of either a toner density setting or a print media source setting proceeds to the selection of complimentary toner density setting or print media source. Insofar as Noyes et al., teach that other selections and choices must be made as opposed to proceeding to default selections based on pre-selections of either toner density setting or print media source.

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case for rejection of Claims 1 - 6 under 35 U.S.C. 103(a) as being unpatentable over Noyes et al.. To establish a *prima facie* case of obviousness,

three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and must not be based on applicant's disclosure. MPEP, 7<sup>th</sup> ed. Revision 1, February 2000, § 706.02(j) citing *In re Vaek*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The burden lies initially with the Examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP, 7<sup>th</sup> ed. Revision 1, February 2000, § 706.02(j) citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The teaching of Noyes et al. provides no motivation for eliminating the option of allowing the user to select the variety of print job characteristics shown for instance in Fig. 44 to arrive at the present invention.

Applicant respectfully submits that the rejection of 1 - 5 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Noyes, et al. should be withdrawn and Claims 1 - 5 allowed.

3. Applicant believes the application is in condition for allowance and respectfully requests the same. If the Examiner is of a differing opinion he/she is hereby requested to conduct a telephonic interview with the undersigned attorney.

Respectfully submitted.

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